

Appl. No.: 09/807,664  
Group Art Unit: 1764  
Response to Paper No. 13

### REMARKS

Claims 11-28 are currently pending in the present application.

In Paper No. 13, the Examiner maintains the previous rejection of claims 11-28 under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent No. 5,439,709 of Becker, *et al.*, (hereinafter referred to as "Becker '709"), and makes the rejection final.

The Examiner states that she is unable to find the "consisting essentially of" language referenced by Applicants in any of the claims. Additionally, the Examiner contends that Becker '709 teaches vegetable-based fatty acid methyl esters, that Becker '709 teaches no preferred ester, and that there is no need to modify the teachings of Becker '709 to arrive at the claimed invention. (See, Paper No. 13, pp. 2-3). The Examiner has previously argued that Becker '709 discloses "a process of lubricating textile fibers comprising contacting said fibers with a smoothing agent consisting of fatty acid methyl esters which have been produced by transesterification of natural triglycerides, . . ." (See, Paper No. 9, p. 2). The Examiner also contends that coconut oil, palm oil, rapeseed oil and soybean oil are disclosed for use as natural triglycerides and that wool is disclosed as a fiber to be lubricated. The Examiner argues that the claimed invention is obvious in light of the disclosure set forth in Becker '709.

Applicants again respectfully traverse the Examiner's rejection and the arguments and contentions set forth in support thereof, for the following reasons.

To begin with, one embodiment of Applicants' claimed invention is directed to "[a] lubricant composition for wool fiber comprising: a mixture of C<sub>6-22</sub> fatty acid methyl esters *consisting essentially of* esters derived from fatty acids selected from the group consisting of coconut fatty acids, palm kernel fatty acids, palm oil fatty acids, and mixtures thereof, and emulsifiers." (See, Claim 25).

Another embodiment of Applicants' claimed invention is directed to "[a] process for lubricating wool for combed wool sliver production, said process comprising: (a) providing wool fiber to be lubricated; (b) providing a lubricant composition comprising a mixture of C<sub>6-22</sub> fatty acid methyl esters based on fatty acids selected from the group consisting of coconut fatty

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acids, palm kernel fatty acids, palm oil fatty acids, and mixtures thereof; and (c) contacting the wool fiber with the lubricant composition." (See, Claim 11).

Applicants would like to highlight for the Examiner the language of claim 25. The claimed composition comprises a mixture of C<sub>6-22</sub> fatty acid methyl esters and emulsifiers, wherein the C<sub>6-22</sub> fatty acid methyl esters *consist essentially of* esters derived from fatty acids selected from the group consisting of coconut fatty acids, palm kernel fatty acids, palm oil fatty acids, and mixtures thereof. **If the Examiner is still unable to find this language in the claims, Applicants respectfully request that the Examiner contact Applicants' undersigned representative by telephone.**

Substantively, Becker '709 fails to teach or suggest Applicants' claimed invention in such a manner as to render Applicants' claimed invention obvious. Becker '709 discloses the use of C<sub>8-22</sub> fatty acid methyl esters as smoothing agents in lubricants for card spinning. (See, Becker '709, col. 1, lines 51-53). Becker '709 does not provide a distinction between animal-based fatty acids and vegetable-based fatty acids, and as the Examiner has noted, Becker '709 discloses the applicability of "natural triglycerides, such as coconut oil, soybean oil, rapeseed oil, sunflower oil, palm oil and tallow, . . ." (See, Becker '709, col. 1, lines 59-63). Becker '709 only exemplifies the use of tallow. (See, Becker '709, Examples). *Ultimately, Becker '709 fails to teach or suggest the exclusion of animal-based fatty acid methyl esters.*

In other words, while Becker '709 may have recognized vegetable-based fatty acid methyl esters as being usable in the disclosed card spinning lubricants, Becker '709 does not teach or suggest a lubricant composition for wool fiber comprising: a mixture of C<sub>6-22</sub> fatty acid methyl esters consisting essentially of esters derived from fatty acids selected from the group consisting of coconut fatty acids, palm kernel fatty acids, palm oil fatty acids, and mixtures thereof; and emulsifiers.

Contrary to the Examiner's assertion, modification of Becker '709 would be required to arrive at Applicants' claimed invention because Becker '709 (*i.e.*, the Examples), teaches the inclusion of animal-based fatty acid methyl esters, and one would need to ignore those teachings and determine that the *exclusion* of specifically taught esters would be

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advantageous. The exclusion of animal-based fatty acid methyl esters is not taught or suggested by Becker '709.

With respect to the embodiment of Applicants' claimed invention which is directed to a process for lubricating wool for combed wool sliver production, it is respectfully submitted that Becker '709 also fails to teach or suggest such a process. Applicants have identified and explained the differences between card spinning and combed wool sliver production, both in the Specification and in the previous response. (*See, e.g.*, Applicants' Spec., pp. 1-3; & Applicants' Request for Reconsideration filed Feb. 6, 2003, pp. 2-3).

Becker '709 does not teach or suggest the use of a lubricant composition comprising a mixture of C<sub>6-22</sub> fatty acid methyl esters based on fatty acids selected from the group consisting of coconut fatty acids, palm kernel fatty acids, palm oil fatty acids, and mixtures thereof *as a lubricant for combed wool sliver production*. Nor does Becker '709 recognize the distinct advantages obtained by using vegetable-based fatty acid methyl esters in combed sliver production.

The Examiner has contended that "the issue is not whether use of vegetable based esters exhibit unexpected results as compared with animal based esters[, but rather,] whether Becker teaches a process for lubricating wool wherein a lubricant composition comprising a mixture of C<sub>6-22</sub> fatty acid methyl esters based on vegetable fatty acids is contacted with wool fibers." (*See*, Paper No. 13, p. 3).

Applicants respectfully disagree with the Examiner's assessment of the issues. Becker '709 does not teach the use of fatty acid methyl ester-containing lubricants *for combed wool sliver production*. Becker '709 is directed to card spinning. Moreover, regardless of what lubricants Becker '709 discloses for use in card spinning, Becker '709 fails to teach processes for combed sliver production. As explained in Applicants' Specification, woolen yarn production and worsted yarn production (employing combed sliver production) have different demands on the lubricants used. (*See, e.g.*, Applicants' Specification, pp. 1-3). Applicants have discovered that the use of vegetable-based fatty acid methyl esters as lubricants for combed wool sliver production results in unexpected advantages over the use of animal-based esters.

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Accordingly, the improvement in combed wool sliver production obtained via Applicants' claimed invention is a relevant issue. Applicants' have discovered an advantage to using vegetable-based ester lubricants in combed wool sliver production. As shown in Applicants' Specification, the use of the inventive lubricant composition exhibits unexpected yield advantages in combed sliver production versus a conventional tallow-based fatty acid ester lubricant. (See, Applicants' Specification, p. 6, line 28, through p. 8). Applicants' specifically state that this advantage is surprising and unexpected. (See, *id.*, at page 3, lines 12-19).

In view of the remarks set forth above, Applicants submit that all pending claims patentably distinguish over the prior art of record and known to Applicants, either alone or in combination. Accordingly, reconsideration, withdrawal of the rejection and a Notice of Allowance for all pending claims are respectfully requested.

Respectfully submitted,

**WOLFGANG BECKER, et al.**

August 22, 2003  
(Date)

By: \_\_\_\_\_

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